

The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSAN H. MATTHEWS

Appeal 2007-4312
Application 09/679,139
Technology Center 3600

Decided: September 26, 2007

Before CHUNG K. PAK, CHARLES F. WARREN, and
THOMAS A. WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 3, 5 through 12, and 14 through 22 in the Office Action mailed May 22, 2002. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 1.191(a)(1) (2003); *see also* 37 C.F.R. § 41.31(a) (September 2004).

We affirm the decision of the Primary Examiner.

Claim 1 illustrates Appellant's invention of a play kit, and is representative of the claims on appeal:

1. A play kit comprising:

a pillow comprising a pillow body and at least two attachment mechanisms that are operably coupled to the pillow, wherein the pillow body comprises a filler material, and wherein the pillow body includes a medial region and a pair of opposing arms that form a generally open well that is open to a surface onto which the pillow is adapted to rest such that a user may lie directly on the surface when lying within the well; and

at least one bar that is positionable over the pillow, with the attachment mechanisms being configured to be attached to the bar, wherein the bar includes at least one coupling mechanism to permit a toy to be coupled to the bar and held above the pillow.

The Examiner relies on the evidence in these references:

Plate	US 3,911,512	Oct. 14, 1975
Williams	US 4,722,713	Feb. 2, 1988
Matthews	US 5,546,620	Aug. 20, 1996
O'Neill	US 5,930,854	Aug. 3, 1999

Appellant requests review of the following grounds of rejection under 35 U.S.C. § 103(a) advanced on appeal (Br. 3):

Claims 1 through 3, 5, 6, 9, 11, 12, 14, 15, and 17 through 22 as unpatentable over Matthews in view of O'Neill (Answer 3);

Claims 7, 8, and 16 as unpatentable over Matthews in view of O'Neill, further in view of Williams (*id.* 4); and

Claim 10 as unpatentable over Matthews in view of O'Neill, further in view of Plate (*id.* 4).

Appellant argues claim 1 as representative of the first ground of rejection. Br. 5 and 9-10. Appellant relies on the arguments with respect to claim 1 with respect to the other grounds of rejection. Br. 10. Thus, we decide this appeal based on claim 1 as representative of the grounds of rejection. 37 C.F.R. § 1.192(c)(7) (2003); *see also* 37 C.F.R.

§ 41.37(c)(1)(vii) (September 2004).

The issue in this appeal is whether the Examiner has carried the burden of establishing a prima facie case of obviousness of claim 1 over the combined teachings of Matthews and O'Neill.

The plain language of claim 1 specifies a play kit comprising at least a pillow comprising at least a pillow body that has two "attachment mechanisms operably coupled" thereto. The pillow body comprises at least a filler material, and in structure, includes at least a medial region and a pair of opposing arms that form a generally open well that is open to a surface onto which the pillow rests "such that a user may lie directly on the surface when lying within the well." This language is illustrated by the embodiment shown in Specification Figs. 1 and 2, wherein pillow body 12 in the shape of a horseshoe or a U, has medial region 14 and opposing arms 16,18 defining three sides of generally open well 20 when the pillow is placed on a surface. Specification 5:18-33. We find no limitation in claim 1 with respect to the position that a body assumes in reclining in the "well" of the pillow body.

The claim requires at least one bar that is/are attached in any manner to the at least two "attachment mechanisms" that are "operably coupled" in any manner to the pillow, such that the at least one bar is positioned over the pillow. The bar(s) include at least one "coupling mechanism" to couple a toy to the bar such that the toy is held above the pillow to any extent. This language is illustrated by the embodiment shown in Specification Figs. 3 and 4, wherein the "at least two attachment mechanisms" are fabric loops 26 coupled by attachment to pillow 10, with curved bars 30, 32 extending

through loops 26 so that ends 34 rest on the surface on which pillow 10 is placed, and the “coupling mechanism” are fabric strips 40 which couple toys 42 to bars 30,32. Specification 5:26-6:16.

The open-ended terms “comprising” and “includes” opens the claim to encompass play kits that contain additional elements such as a toy directly attached to the pillow body. *See, e.g., Vehicular Technologies Corp. v. Titan Wheel Int’l, Inc.*, 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed. Cir. 2000); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”); *see also In re Bertsch*, 132 F.2d 1014, 1019, 56 USPQ 379, 384 (CCPA 1942) (“it is true that the word ‘comprising’ is usually in patent law held to be synonymous with the word ‘including’”); *cf. Ex parte Davis*, 80 USPQ 448, 449 (Bd. App. 1948) (“the word ‘comprising’ alone being synonymous with ‘including’”).

We will not, of course, read the illustrative embodiments into the claims as limitations. *See, e.g., In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We agree with the Examiner’s findings of fact from Matthews and O’Neill. Answer 3-4 and 5-9. We add the following thereto for emphasis. We find Matthews would have disclosed to one of ordinary skill in this art a resilient support cushion 12 formed from any cushioning materials, in the shape of a horseshoe or a U, that has medial region 14 and opposing arms 16,18 defining three sides of generally open well 20 when the cushion is

placed on a surface, which can receive a body without regard to the position the body assumes in the well of the cushion. Matthews, col. 1, ll. 40-66, col. 2, ll. 1-2 and 36-55, col. 3, ll. 32-35, and Figs. 1-4. The pillow has one or straps 50 operably coupled to pillow 10 which function as attachment or coupling mechanisms for toys, and can be attached at any location on pillow 10 such that toys can be coupled to any part of the pillow. *Id.*, e.g., col. 1, ll. 40-45 and 55-57, col. 4, ll. 10-36, and Figs. 1-3.

We find O'Neill would have disclosed to one of ordinary skill in this art a resilient support which can be in a C- or U-shape and can be made of a resistant, cushionable, and deformable material, such as foam, or can be inflatable. O'Neill, col. 1, ll. 33-43 and 50-54. We find no limitation in O'Neill with regard to the position a body can assume in the well of a C- or U-shaped support. The support can include a cover which can be closed by a zip fastener. *Id.* col. 2, ll. 19-35. The support includes means such as loops 16 to secure several struts or bars 26 that form a frame over the support, the ends of struts 26 resting on the surface on which the support is placed, wherein the struts have cover means to couple toys thereto in a manner to suspend the toys above the support. *Id.* col. 1, ll. 35-40, col. 2, l. 36 to col. 3. l. 18, col. 3, l. 66 to col. 4, l. 43, and Figs. 1-4. O'Neill illustrates the invention with inflatable embodiments.

We determine the combined teachings of Matthews and O'Neill, the scope of which we determined above, provide convincing evidence supporting the Examiner's case that the claimed play kit encompassed by claim 1, as we interpreted this claim above, would have been *prima facie* obviousness of to one of ordinary skill in the baby and child

accommodation, amusement, and education arts familiar with support accommodations which include means to place entertaining and educational toys within the environment of a baby or child situated on the support. We agree with the Examiner's positions in the grounds of rejection and in the responses to Appellant's contentions. Answer in entirety. We add the following for emphasis.

We are of the opinion Appellant's contentions are not sufficient to rebut the Examiner's prima facie case of obviousness. Contrary to Appellant's contentions (Br. 5-9), we determine that one of ordinary skill in the art would have readily combined Matthews and O'Neil, and thence would have reasonably been led by the combined teachings to the claimed play kit encompassed by claim 1, including all of the limitations thereof arranged as required therein, without resort to Appellant's Specification. Indeed, this person would have recognized the similarity of Matthews' U-shaped support and the U-shaped support disclosed by O'Neill, each forming a generally open well to accommodate the user, and of the attachment mechanisms by which to couple toys to the support. This person would have been led by the teachings of the attachment mechanisms in each reference to attach toys thereto in the manner shown in each reference. Thus, the combined teachings would have resulted in, among other things, a support in which toys are suspended over that support by means of struts or bars as shown by O'Neill using the attachment mechanisms shown in either Matthews or O'Neill, and in the combination of toys directly attached to the support as shown by Matthews and suspended over that support as shown by O'Neill using the attachment mechanisms taught by both reference, both

modifications resulting in a support with toys falling within claim 1. Indeed, this person would have had a reasonable expectation of successfully obtaining a support with attached toys in either respect. *See, e.g., KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007) (a patent claiming a combination of elements known in the prior art is obvious if the improvement is no more than the predictable use of the prior art elements according to their established functions); *In re Kahn*, 441 F.3d 977, 985-88, 78 USPQ2d 1329, 1334-37 (Fed. Cir. 2006); *see also In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981);¹ *see also In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-681 (Fed. Cir. 1988) ("Obviousness does not require absolute predictability of success. . . . For obviousness under § 103, all that is required is a reasonable expectation of success." (citations omitted)).

We are not convinced by Appellant's contention that the different positions of the toys relative to the support militate against combining the teachings of the references leading to the claimed invention as one of ordinary skill in this art would have recognized the difference in accessibility of the toys to a person on the support and the benefits of each. The location of the attachment mechanisms in Matthews is also not

¹ The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Keller, 642 F.2d at 425, 208 USPQ at 881.

persuasive as the reference does not limit the location. Similarly, O'Neill does not limit the support therein to an inflatable one. In this respect, it is well settled that non-preferred and non-illustrated embodiments in a reference are fully considered in comparing the claimed invention with the reference. *See, e.g., In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) (“[T]he fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.”).

We further find no teaching in Matthews or in O'Neill which would teach away from combining the teachings or arriving at the claimed invention in view of the similarities in the teachings of these references we find and discuss above. *See, e.g., Kahn*, 441 F.3d at 985-89, 78 USPQ2d at 1334-338 (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” (quoting *In re Gurley*, 27 F.3d 551, 553 [31 USPQ2d 1130, 1131], (Fed. Cir. 1994))); *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1145-146 (Fed. Cir. 2004) (prior art “disclosure does not criticize, discredit, or otherwise discourage the solution claimed”). Finally, we find no limitation in claim 1 or in either Matthews or O'Neill on the manner in which a baby or child must be arranged in or on the support to either be supported thereby or to engage the toys. *See In re Self*, 671 F.2d 1344, 1348-349, 213 USPQ 1, 5 (CCPA 1982). Indeed, the continual random movement of babies and small

children is well recognized, and Matthews illustrates at least two of the myriads of possible positions that can be assumed on a U-shaped support.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Matthews and O'Neil and the further combination thereof with Williams and with Plate, with Appellant's countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 3, 5 through 12, and 14 through 22 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The Primary Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834